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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/827,468

04/19/2004

Bryan M. Buchi

3053.2.2

2980

7590 04/11/2008
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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

04/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/827,468	BUCHI, BRYAN M.	
	Examiner	Art Unit	
	William V. Gilbert	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) 27-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a First Action following a Request for Continued Examination. Claims 1-5 and 21-34 are pending. Claims 6-20 are cancelled. Claims 27-34 are withdrawn from consideration. Claims 1-5 and 21-26 are examined below.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 January 2008 has been entered.

Claim Objections

2. Applicant is advised that should claim 5 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the

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other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope (U.S. Patent No. 3,715,417) in view of Donatti (U.S. Publication 2004/0247887).

Claims 1 and 22: Pope discloses an artificial cover (Fig. 2A) for covering an underlying structure (see Fig. 1, generally) having a first side (14) with a three dimensional pattern protruding from the first side of stone (Col. 2, lines 41-47), a second side (15) configured to contact and attach to the underlying structure, the panel has a surface skin (19), the cover has rigidity to prevent sagging upon securing to the structure and no liner is present in the matrix of the artificial cover. While Pope discloses three dimensional products as stone (or numerous materials, which could include polyurethane faux stone by one of ordinary skill in the art), it does not disclose the stones extending at acute angles. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the aesthetic limitations as claimed because matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See M.P.E.P. §2144.04(I) citing *In re Seid*, 161 F.2d 229 (CCPA 1947). Further, while it is well known to color such coverings (in particular 14 and 19) for aesthetic reasons, it does not disclose the colorant is disposed in the skin. Donatti discloses a panel with a polyurethane skin that has color injected in the matrix. It

would have been obvious at the time the invention was made to a person having ordinary skill in the art to use this to incorporate the color into the matrix in order to make a member of any desired color.

Claims 2 and 24: the cover is polyurethane (Col. 2, lines 40-45).

Claims 3, 4 and 25: while the prior art of record discloses a foundation (Pope: proximate 22) it does not disclose the foundation is that of a home or a staircase. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the foundation as a home or staircase because a home or a staircase is a structure and the skin is fully capable of functioning properly if the structure were a home or staircase.

Claims 21 and 23: while Pope discloses three dimensional products as stone (or numerous materials, which could include faux stone), it does not disclose the stones extending at acute angles. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the aesthetic limitations as claimed because matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See

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M.P.E.P. §2144.04(I) citing *In re Seid*, 161 F.2d 229 (CCPA 1947).

Claims 5 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope in view of Donatti and Price (U.S. Patent No. 6,691,471).

Claims 5 and 26: the prior art of record discloses the claimed invention including that nails (Col. 3, lines 10-20) can be used to attach the panel to the structure, but it does not disclose screws. Price discloses a panel and structural system where screws (Col. 3, lines 50-55) are used for attachment. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use screws to attach the panels to the structure because screws are a functional equivalent to nails as used in the present invention and would perform equally as well.

Response to Arguments

4. The following addresses applicant's remarks/arguments dated 30 January 2008:

Drawing Objection:

Applicant's remarks regarding the drawing objections are noted by the examiner and the objection is withdrawn.

Rejection: 35 USC §112:

Applicant's clarification/explanation as a result of the rejection is noted and the rejection is withdrawn.

Response: Rejection under 35 USC §103:

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as applicant amended the claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./
Examiner, Art Unit 3635
/Basil Katcheves/
Primary Examiner, Art Unit 3635